UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,821	04/27/2001	Doo Sang Park	2080-3-18	3336

35884   7590   07/10/2008
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ART UNIT	PAPER NUMBER
2142	

MAIL DATE	DELIVERY MODE
07/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 April 2008_.

2a)☐ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-5,7-14 and 16-22_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-5,7-14 and 16-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some *   c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to correspondence filed 11 April 2008.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-5, 7-14 and 16-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gerszberg et al. (US 6,359,881 B1), hereinafter referred to as

Gerszberg '881, in view of Kondo et al. (US 5,936,941), hereinafter referred to as

Kondo, in view of Gerszberg et al. (US 2001/0040621), hereinafter referred to as

Gerszberg '621.

4.   Regarding claim 1, Gerszberg '881 teaches an information display system,

comprising:

        a gateway system for converting protocols of an external network and a local

network for information exchange between the external network and local network (Fig.

5, item 210, gateway, and col. 13, ll. 41-43);

        a plurality of terminals having a display unit and connected to the local network

wherein each of the plurality of terminals exchanges call setup information with the

gateway system (Fig. 5, item 210 gateway and item 214 connection manager, and col.

13, ll. 41-50).

Gerszberg '881 teaches an information server for receiving and storing information transmitted from the external network or local network (fig. 4B item 183 info server/DBMS and col. 10, ll. 28-34) and the transmission of information to a plurality of terminals (Gerszberg '881, col. 11, ll. 59-61) and wherein each of the plurality of terminals that is in the on-hook status displays the information transmitted from the information server on the display unit (Gerszberg '881, col. 11, ll. 65-66) and the displayed information is at least one of an advertisement, a guide and a bulletin (Gerszberg '881, col. 11, ll. 58-62). Gerszberg '881 does not explicitly teach (a) "determining a call status of each of the plurality of terminals based on call status information included in the call setup information exchanged between each of the plurality of terminals" and (b) "transmitting the stored information to each of the plurality of terminals during an on-hook status after determining the on-hook status of each of the plurality of terminals."

(a) With respect to call status determination, Gerszberg '881 does not explicitly teach these limitations. However, in related art, Kondo teaches the determination of call status information from call setup information wherein Kondo teaches wherein a communication terminal identifies status information and stores the information at a management terminal (col. 8, ll. 8-34). The status information is retrieved from call setup information that is originally transmitted from a device (col. 8, ll. 30-34). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to determine call status from call setup information as taught by Kondo. One of ordinary skill in the art would have been motivated to combine Kondo with Gerszberg '881

wherein Kondo teaches an efficient management method with respect to a plurality of terminals and enables quick maintenance of the communication terminals (col. 1, ll. 10-16).

(b) With respect to the transmission of stored information during an on-hook status, Gerszberg '881 teaches the transmission of information to the terminal at any point in time, therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to enable information to be transmitted to the videophone while the videophone is in an on-hook condition. This is taught in the art by Gerszberg '621, wherein Gerszberg teaches a very similar videophone wherein information, advertisements, is transmitted to a videophone when it is determined that the videophone is not in use (p. 5, para. 0042) and therefore the videophone is in an on-hook condition. One of ordinary skill in the art would have been motivated to utilize the transmission during an on-hook status wherein Gerszberg teaches that it would have been advantageous to push information to a terminal during low use times in the middle of the night or when the videophone is not in use at all (Gerszberg '621, p. 5, para. 0042).

5.   Regarding claim 2, Gerszberg '881, Kondo and Gerszberg '621 teach the system wherein each of the plurality of terminals is one of a PC phone and an Internet phone using Internet protocols for data communication (Gerszberg '881, col. 6, ll. 47-50).

6.   Regarding claim 3, Gerszberg '881, Kondo and Gerszberg '621 teach the system wherein each of the plurality of terminals includes a memory means for temporarily storing the information transmitted from the information server (Gerszberg '881, col. 8,

ll. 44-52) during the on-hook status (Gerszberg '621, p. 5, para. 0042) and a control

means for controlling the storing of the transmitted information in the memory means

such that the information stored in the memory means is displayed on the display unit

when the on-hook status is detected (Gerszberg '881, col. 11, ll. 65-66) and voice

communication-related information is displayed on the display unit when an off-hook

status is detected (Gerszberg '881, col. 9, ll. 17-27).

7.   Regarding claim 4, Gerszberg '881, Kondo and Gerszberg '621 teach the system

wherein the control means in each of the plurality of terminals determines the call status

of the terminal (Gerszberg '881, col. 11, ll. 65-66).

8.   Regarding claim 5, Gerszberg '881, Kondo and Gerszberg '621 teach the system

wherein the call status is one of the on-hook status and the off-hook status (Gerszberg

'881, col. 11, ll. 65-66, A phone is either in active use or not in active use.).

9.   Regarding claim 7, Gerszberg '881, Kondo and Gerszberg '621 teach the system

wherein the information server comprises a memory means for storing information

transmitted from the external network (Gerszberg '881, col. 10, ll. 28-37) and a control

means for determining the respective call status of each of the plurality of terminals

(Gerszberg '621, pg. 5, paragraph 0042).

10.   Regarding claim 8, Gerszberg '881, Kondo and Gerszberg '621 teach the system

wherein the control means of the information server transmits the information stored in

the memory means of the information server to each of the plurality of terminals during

the on-hook status of each of the plurality of terminals (Gerszberg '621, pg. 5, para.

0042).

11.   Regarding claim 9, Gerszberg '881, Kondo and Gerszberg '621 teach the system

wherein the control means of the information server updates contents of the memory

means of the information server when new information is received (Gerszberg '881, col.

12, ll. 12-17, delivery of emergency broadcasts.).

12.   Regarding claim 10, Gerszberg '881 teaches an information display system,

comprising:

a plurality of terminals having a display unit and connected to the local network

(Fig. 5, item 210 gateway and item 214 connection manager, and col. 13, ll. 41-50).

Gerszberg '881 teaches an information server for receiving and storing

information transmitted from the external network or local network (fig. 4B item 183 info

server/DBMS and col. 10, ll. 28-34) and the transmission of information to a plurality of

terminals (Gerszberg '881, col. 11, ll. 59-61) and wherein each of the plurality of

terminals that is in the on-hook status displays the information transmitted from the

information server on the display unit (Gerszberg '881, col. 11, ll. 65-66) and the

displayed information is at least one of an advertisement, a guide and a bulletin

(Gerszberg '881, col. 11, ll. 58-62). Gerszberg '881 does not explicitly teach (a)

"determining a call status of each of the plurality of terminals based on call status

information included in the call setup information exchanged between each of the

plurality of terminals" and (b) "transmitting the stored information to each of the plurality

of terminals during an on-hook status after determining the on-hook status of each of

the plurality of terminals."

(a) With respect to call status determination, Gerszberg '881 does not explicitly teach these limitations. However, in related art, Kondo teaches the determination of call status information from call setup information wherein Kondo teaches wherein a communication terminal identifies status information and stores the information at a management terminal (col. 8, ll. 8-34). The status information is retrieved from call setup information that is originally transmitted from a device (col. 8, ll. 30-34). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to determine call status from call setup information as taught by Kondo. One of ordinary skill in the art would have been motivated to combine Kondo with Gerszberg '881 wherein Kondo teaches an efficient management method with respect to a plurality of terminals and enables quick maintenance of the communication terminals (col. 1, ll. 10-16).

(b) With respect to the transmission of stored information during an on-hook status, Gerszberg '881 teaches the transmission of information to the terminal at any point in time, therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to enable information to be transmitted to the videophone while the videophone is in an on-hook condition. This is taught in the art by Gerszberg '621, wherein Gerszberg teaches a very similar videophone wherein information, advertisements, is transmitted to a videophone when it is determined that the videophone is not in use (p. 5, para. 0042) and therefore the videophone is in an on-hook condition. One of ordinary skill in the art would have been motivated to utilize the transmission during an on-hook status wherein Gerszberg teaches that it would have

been advantageous to push information to a terminal during low use times in the middle

of the night or when the videophone is not in use at all (Gerszberg '621, p. 5, para.

0042).

13.   Regarding claim 11, Gerszberg '881, Kondo and Gerszberg '621 teach the

system wherein each of the plurality of terminals is one of a PC phone and an Internet

phone using Internet protocols (Gerszberg '881, col. 6, ll. 47-50).

14.   Regarding claim 12, Gerszberg '881, Kondo and Gerszberg '621 teach the

system wherein each of the plurality of terminals includes a memory means for storing

information transmitted from the information system (Gerszberg '881, Fig. 3B, item 173)

and a control means for controlling storing of the transmitted information in the memory

means (Gerszberg '881, Fig. 3B, item 170) such that the information stored in the

memory means is displayed on the display unit when the on-hook status is detected

(Gerszberg '881, col. 11, ll. 58-62) and voice communication- related information is

displayed on the display unit when an off-hook status is detected (col. 9, ll. 17-21).

15.   Regarding claim 13, Gerszberg '881, Kondo and Gerszberg '621 teach the

system wherein the control means of each of the plurality of terminals determines the

call status of the terminal (Gerszberg '881, col. 11, ll. 65-66).

16.   Regarding claim 14, Gerszberg '881, Kondo and Gerszberg '621 teach where in

the call status is one of the on-hook status and the off-hook status (Gerszberg '881, col.

11, ll. 65-66, A phone is either in active use or not in active use.).

17.   Regarding claim 16, Gerszberg '881, Kondo and Gerszberg '621 teach the

system wherein the information system comprises a memory means for storing the

information transmitted from the external network (Gerszberg '881, col. 10, ll. 28-37)

and a control means for determining the call status of each of the plurality of terminals

(Gerszberg '621, pg. 5, paragraph 0042).

18.   Regarding claim 17, Gerszberg '881, Kondo and Gerszberg '621 teach the

system wherein the control means of the information system transmits the information

stored in the memory means of the information system to each of the plurality of

terminals during the on-hook status of each of the plurality of terminals (Gerszberg '621,

pg. 5, para. 0042).

19.   Regarding claim 18, Gerszberg '881, Kondo and Gerszberg '621 teach the

system wherein the control means of the information system updates contents of the

memory means of the information system when new information is received (Gerszberg

'881, col. 12, ll. 12-17, delivery of emergency broadcasts.).

20.   Regarding claim 19, Gerszberg '881 teaches an information display system,

comprising:

        storing information transmitted from an external network or a local network (fig.

4B item 183 info server/DBMS and col. 10, ll. 28-34).

        Gerszberg '881 teaches an information server for receiving and storing

information transmitted from the external network or local network (fig. 4B item 183 info

server/DBMS and col. 10, ll. 28-34) and the transmission of information to a plurality of

terminals (Gerszberg '881, col. 11, ll. 59-61) and wherein each of the plurality of

terminals that is in the on-hook status displays the information transmitted from the

information server on the display unit (Gerszberg '881, col. 11, ll. 65-66) and the

displayed information is at least one of an advertisement, a guide and a bulletin (Gerszberg '881, col. 11, ll. 58-62). Gerszberg '881 does not explicitly teach (a) "determining a call status of each of the plurality of terminals based on call status information included in call setup information transmitted from each of the plurality of terminals" and (b) "transmitting the stored information to a plurality of terminals connected to the local network during an on-hook status of each of the plurality of terminals."

(a) With respect to call status determination, Gerszberg '881 does not explicitly teach these limitations. However, in related art, Kondo teaches the determination of call status information from call setup information wherein Kondo teaches wherein a communication terminal identifies status information and stores the information at a management terminal (col. 8, ll. 8-34). The status information is retrieved from call setup information that is originally transmitted from a device (col. 8, ll. 30-34). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to determine call status from call setup information as taught by Kondo. One of ordinary skill in the art would have been motivated to combine Kondo with Gerszberg '881 wherein Kondo teaches an efficient management method with respect to a plurality of terminals and enables quick maintenance of the communication terminals (col. 1, ll. 10-16).

(b) With respect to the transmission of stored information during an on-hook status, Gerszberg '881 teaches the transmission of information to the terminal at any point in time, therefore it would have been obvious to one of ordinary skill in the art at

the time of the applicant's invention to enable information to be transmitted to the

videophone while the videophone is in an on-hook condition. This is taught in the art by

Gerszberg '621, wherein Gerszberg teaches a very similar videophone wherein

information, advertisements, is transmitted to a videophone when it is determined that

the videophone is not in use (p. 5, para. 0042) and therefore the videophone is in an on-

hook condition. One of ordinary skill in the art would have been motivated to utilize the

transmission during an on-hook status wherein Gerszberg teaches that it would have

been advantageous to push information to a terminal during low use times in the middle

of the night or when the videophone is not in use at all (Gerszberg '621, p. 5, para.

0042).

21.   Regarding claim 20, Gerszberg '881, Kondo and Gerszberg '621 teach the

method wherein the stored information is transmitted to each of the plurality of terminals

based on the call status of a pre-selected one of the plurality of terminals (Gerszberg

'881, col. 12, ll. 12-17, delivery of emergency broadcasts and news bulletins to certain

users.).

22.   Regarding claim 21, Gerszberg '881, Kondo and Gerszberg '621 teach the

method wherein displaying the transmitted information comprises:

        storing the received information at each of the plurality of terminals (Gerszberg

'881, col. 8, ll. 44-52);

        determining the call status of each of the plurality of terminals (Gerszberg '621, p.

5, para. 0042);

displaying the stored information on each of the plurality of terminals during the

on-hook status (Gerszberg '881, col. 11, ll. 65-66).

23.   Regarding claim 22, Gerszberg '881, Kondo and Gerszberg '621 teach the

method further comprising:

ceasing displaying the stored information and displaying voice communication-

related information on at least one of the plurality of terminals that assumes an off-hook

status (Gerszberg '881, col. 9, ll. 17-27); and

re-displaying the stored information when the at least one of the plurality of

terminals resumes the on-hook status (Gerszberg '881, col. 11, ll. 65-66).

Response to Arguments

24.   Applicant's arguments filed 11 April 2008 have been fully considered but they are

not persuasive.

<u>Claims 1-22 rejected under 35 USC 103(a)</u>

25.   With respect to the rejection of claims 1-22 under 35 USC 103(a) as being

unpatentable over Gerszberg et al. ("Gerszberg '881" US 6,359,881) in view of

Gerszberg et al. ("Gerszberg '621" US 2001/0040621), applicant argues that (a) the

videophones of Gerszberg '881 and Gerszberg '621 may be similar in a way as

asserted by the Examiner, there is at least one significant difference between the

videophones making it impossible to combine these two references to arrive at the

presently claimed invention and one of ordinary skill in the art would not look to

Gerszberg '621 to modify the Gerszberg '881 invention without the benefit of

impermissible hindsight... (b) Gerszberg '621 discloses contradictory features for the

similar videophone as Gerszberg '881, teaches away from the asserted combination of references and, therefore, the combination of Gerszberg '881 and Gerszberg '621 is improper and cannot be relied upon to disclose or suggest "the information stored in the memory unit is displayed on a display unit of each of the plurality of terminals during the on-hook status" as recited in amended independent claims 1 and 10 and "displaying the information temporarily stored at each of the plurality of terminals on a display unit of each of the plurality of terminals during an on-hook status" as recited in amended independent claim 19, (c) Gerszberg '881 and Gerszberg '621 fail to teach "the information stored in the memory unit is at least one of an advertisement, a guide and a bulletin" as recited in claims 1, 10 and 19, (d)

26.   In response to argument (a), the examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gerszberg '881 teaches in column 11, lines 59-61, the transmission of information (i.e. advertisements) to the terminal at any point in time. Gerszberg '881 does not explicitly teach the transmission at specific points in time (i.e. on-hook condition). In related art, Gerszberg '621 teaches on this aspect wherein Gerszberg '621 teaches in paragraph 0042, page 5, a system

wherein when a videophone is in an on-hook condition, information (i.e. advertisements) can be transmitted to the videophone. The teaching by Gerszberg '621 is deemed an obvious variation that can be implemented with the Gerszberg '881 teachings. One of ordinary skill in the art would have been motivated to improve the videophone taught by Gerszberg '881 with the teaching of Gerszberg '621 wherein it would have been advantageous to push information to a terminal during low use times as taught by Gerszberg '621 in page 5, paragraph 0042. With respect to the applicant's assumption of impermissible hindsight reasoning, the examiner respectfully disagrees. The examiner does not rely upon the teachings set forth by the Gerszberg '621 reference with respect to how or when advertisements are displayed. The Gerszberg '621 reference is merely relied upon for when information is transmitted as set forth in the above rejection. The examiner therefore does not agree with the applicant's argument with respect to impermissible hindsight. Further, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

27.   In response to argument (b) the examiner respectfully disagrees. With respect to the combination set forth and Gerszberg '621 teaching away, the examiner maintains that the rejection is proper because a prior art's mere disclosure of more than one alternative does not constitute a teaching away. See MPEP 2141.02. The sending of information to a device in a networked system is deemed an obvious variation in the art as set forth by Gerszberg '621. Gerszberg '621 is not relied upon in the rejection for

teaching the aspect of displaying information during an on-hook status. Gerszberg '881

is relied upon for this aspect wherein Gerszberg '881 teaches in column 11, lines 65-66

wherein when the videophone is not in use (i.e. on-hook), advertising can be displayed

to a user and therefore teaches: "displaying of the stored information on the display of

the terminal when the terminal enters an on-hook status" and "displaying the information

temporarily stored at each of the plurality of terminals on a display unit of each of the

plurality of terminals during an on-hook status."

28.   In response to argument (c), the examiner respectfully disagrees. Gerszberg

teaches in column 8, lines 44-52 the utilization of a memory means to store information

for display. It is unclear in the computer arts how information could be displayed on a

unit's display without being stored on a memory in some capacity. The utilization of a

memory is therefore found to be an inherent aspect of Gerszberg '881 and therefore

teaches the system wherein each of the plurality of terminals includes a memory means

for storing information transmitted from the information server.

29.   Applicant's argument, see Remarks, page 12, filed 11 April 2008, with respect to

the rejection(s) of claim(s) 1-22 under 35 USC 103(a) that the cited prior art does not

teach "determining a call status of each of the plurality of terminals that is based on call

status information included in the call setup information exchanged between each of the

plurality of terminals and the gateway system" as recited by independent claim 1 and

similarly recited by independent claims 10 and 19 has been fully considered and is

persuasive. Therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Gerszberg et al. (US

6,359,881 B1), Kondo et al. (US 5,936,941) and Gerszberg et al. (US 2001/0040621).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Ailes whose telephone number is (571)272-3899. The examiner can normally be reached Monday-Friday, 5:30-8:30AM, 1:00-6:00PM, IFP Hoteling schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BAA

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142